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09/587,721

06/05/2000

Winga Ho

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BEYER WEAVER LLP

P.O. BOX 70250

OAKLAND, CA 94612-0250

EXAMINER

BOUTAH, ALINA A

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WINGA HO

Appeal 2008-0050
Application 09/587,721
Technology Center 2100

Decided: July 15, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY,
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING APPELLANT TO BRIEF AN
ADDITIONAL MATTER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. Winga Ho ("Ho" or "the Appellant") appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b) and exercise our jurisdiction in addressing two issues.

II. SUMMARY OF CLAIMED SUBJECT MATTER

When the Appellant filed the *Appeal Brief (Substitute)*, such a brief was required to include "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, **and to the drawing, if any, by reference characters.**" 37 C.F.R. § 41.37(c)(1)(v)(2006)(emphasis added).¹ "Because it enables the Board to more quickly determine where the claimed subject matter is described in a patent application, reference to such characters is always important." *Ex parte Nelson*, No. 2007-3534, 2008 WL 1957935 (BPAI 2008).

Here, although the Appellant's *Summary of Claimed Subject Matter* refers to pages and line numbers of the Specification (Sub. Appeal Br. 2-4), it does not refer to any of Ho's eight figures, let alone to any of the reference characters thereof.

We decline to substitute our speculation for the greater certainty that should come from Ho. More specifically, the Appellant must submit a substitute *Summary of Claimed Subject Matter* that maps the individual limitations of each of independent claims 1 and 17 to individual reference characters of the figures.

¹ We cite to the version of the Code of Federal Regulations in effect when Ho filed the *Appeal Brief (Substitute)*.

III. PLURAL REPLY BRIEFS

An appellant may file a single "reply brief to an examiner's answer within two months from the date of the examiner's answer." 37 C.F.R. § 41.41(a)(1).

Here, the record includes a plurality of examiner's answers, each followed by a reply brief. Because § 41.41(a)(1) permits only a single reply brief, we will consider only one of the Appellant's reply briefs. More specifically, we will consider only the last Third Reply Brief, which was filed July 17, 2007 and follows the only answer that was not defective. If the Appellant wishes us to consider one of the other reply briefs, that choice must be made in writing along with the aforementioned substitute *Summary of Claimed Subject Matter*

IV. CONCLUSION

Because of the aforementioned omissions, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999). Under 37 C.F.R. § 41.50(d), we give the Appellant a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of this appeal. 37 C.F.R. § 41.50(d).

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

rwk

BEYER WEAVER LLP
P.O. BOX 70250
OAKLAND CA 94612-0250